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EXAMINER

MURPHY, DILLON J

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/073,964	Applicant(s) FUJINAWA, OSAMU	
	Examiner Dillon J. Murphy	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the amendment filed on February 2, 2006.
- Claims 1-44 are pending.
- Amendments to the specification are acknowledged and accepted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US 2003/0123079), and Keeney et al. (US 6,748,471), hereafter referred to as Yamaguchi and Keeney.

Regarding claim 1, Yamaguchi teaches a print system comprising a printer device and a host that is connected to the printer device and provides contents to the printer device (Yamaguchi, fig 1, digital copier #1, client #9, internet (not numbered) and WWW Server #11, wherein the WWW server provides contents to the digital copier). Yamaguchi also teaches the printer device is provided with a printer identification (Yamaguchi, paragraph 121-122, printer address identifies printer as a recipient of content), including a nonvolatile memory (Yamaguchi, fig 2, hard disc #3, and core comprising mem #123, which is RAM and ROM storing printer applications and information) holding a delivery request information table storing access destination

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addresses (Yamaguchi, paragraph 119-120, URL provides destination address of content. Additionally, organizing information in tabular format is well known in the art) and specific information about the printer device including the printer identification (Yamaguchi, paragraph 121-122, printer address identifies printer as a recipient of content. Print settings, specific to printer, can be seen in table 1, comprising sheet style, margins, sorting, duplex printing, etc.), executing a delivery request of the contents to the host by sending the delivery request information table to the host, and receiving print data of the contents from the host to print the print data (Yamaguchi, paragraph 16, wherein imaging device sends delivery request to WWW server, and wherein the printer receives the print data to be printed accordingly). Yamaguchi does not teach a print system further comprising the host receiving the delivery request information table from the printer device, determining whether the requested contents should be delivered according to the printer identification included in the received delivery request information table, producing the print data of the contents on the basis of the specific information about the printer device, and delivering the print data to the printer device. Furthermore, the functionality of Yamaguchi is provided in part by the client computer, although it will be shown how the functionality may be provided completely by the printer. Keeney teaches a print system comprising a printer device and a host connected to the printer, wherein the functionality is provided by the printer (Keeney, col 7, ln 50-60, printer polling device which controls communication of the printer, may be integrated into the printer or may be an external device, or incorporated into a print server, i.e. a host. Thus, using the teachings of Keeney, the functionality of

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Yamaguchi may be realized in the printer), wherein the host receives the delivery request information table from the printer device, determines whether the requested contents should be delivered according to the printer identification included in the received delivery request information table (Keeney, for example, col 10, ln 56-63, a list of recipients is located at the host, allowing the host to determine if the contents should be delivered), produces the print data of the contents on the basis of the specific information about the printer device, and delivers the print data to the printer device (Keeney, col 14, ln 1-10, as part of the polling query, i.e. deliver request information table, the print data is produced in accordance with the printer specifics, and the data is delivered to the printing device to be printed).

Yamaguchi and Keeney are combinable because they are from a similar field of endeavor of printing systems wherein the printing device requests printing jobs from content providers. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printing system of Keeney comprising the host receiving the delivery request information and the preparation of the corresponding print data, as well as the teachings of Keeney including locating the polling operations in the printer, with the print system of Yamaguchi comprising a printing device with nonvolatile memory storing printer identification, delivery request information, destination addresses, and printer identification information, wherein the printing device executes a delivery request from the host and prints the contents. The motivation for doing so would have been to provide a printing system based on "pull" technology to allow users to print through any kind of network, and to print to an unknown destination printer in a

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reliable, efficient, and secure manner (Keeney, col 2, ln 45-57), as well as to provide a printing system which can directly obtain data of a WWW server while also reducing load on the network (Yamaguchi, paragraph 9). Therefore, it would have been obvious to combine Keeney with Yamaguchi to obtain the invention as specified in claim 1.

Regarding claim 2, which depends from claim 1, the combination of Yamaguchi and Keeney teaches a print system wherein the printer device further includes a timer and the delivery request information table further stores an access time and an access period, and when the timer clocks the access time and the access period stored in the delivery request information table, the printer device accesses the access destination address and requests the host to deliver the contents (Yamaguchi, paragraph 25, content is accessed and printed according to a predetermined frequency, i.e. access time and an access period. Inherently, the printing system of Yamaguchi must comprise a timer to track time periods. See also paragraph 241, wherein the access time and period are set, also seen in figs 20-22).

Regarding claim 3, which depends from claim 1, the combination of Yamaguchi and Keeney teaches a print system wherein the printer device further includes a delivery request means, and when the delivery request means inputs the delivery request, the printer device accesses the access destination address and requests the host to deliver the contents (Yamaguchi, paragraph 16-18, for example, wherein the image forming apparatus access and obtains information from the WWW server, i.e. comprises a delivery request means, wherein the destination address is accessed and the content is provided to the printer for printing).

Regarding claim 4, which depends from claim 2, claim 4 recites identical features as claim 3 except claim 3 is dependent on claim 1. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 4.

Regarding claim 5, which depends from claim 1, the combination of Yamaguchi and Keeney teaches a print system wherein the host obtains the specific information about the printer device from the delivery request information table and delivers the contents according to the specific information to either the printer device or a delivery request terminal (Yamaguchi, paragraph 36-37, wherein the WWW server, i.e. the host, receives the delivery request from the imaging device, and delivers the contents according to the specific information of the printing device, such as the address information and frequency information).

Regarding claim 6, which depends from claim 2, claim 6 recites identical features as claim 5 except claim 5 is dependent on claim 1. Thus, arguments similar to that presented above for claim 5 are equally applicable to claim 6.

Regarding claim 7, which depends from claim 3, claim 7 recites identical features as claim 5 except claim 5 is dependent on claim 1. Thus, arguments similar to that presented above for claim 5 are equally applicable to claim 7.

Regarding claim 8, which depends from claim 1, the combination of Yamaguchi and Keeney teaches a print system wherein the host obtains information about a past record of the contents obtained by either the printer device or a delivery request terminal from the delivery request information table and controls either the printer device or the delivery request terminal so that the printer device can print the specified

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contents for a limited number of times (Keeney, col 4, ln 50-55, wherein the lifetime of a print job is designated, and the number of printings may be set so the print job may only be printed the designated number of times. The lifetime, i.e. past record of the contents, is kept by the server, i.e. host providing content).

Regarding claim 9, which depends from claim 2, claim 9 recites identical features as claim 8 except claim 8 is dependent on claim 1. Thus, arguments similar to that presented above for claim 8 are equally applicable to claim 9.

Regarding claim 10, which depends from claim 3, claim 10 recites identical features as claim 8 except claim 8 is dependent on claim 1. Thus, arguments similar to that presented above for claim 8 are equally applicable to claim 10.

Regarding claim 11, which depends from claim 5, claim 11 recites identical features as claim 8 except claim 8 is dependent on claim 1. Thus, arguments similar to that presented above for claim 8 are equally applicable to claim 11.

Regarding claim 12, which depends from claim 1, the combination of Yamaguchi and Keeney teaches a print system wherein the host separately controls charged and free contents according to the printer identification or a delivery request terminal identification, and when the contents requested for delivery are charged, a user is charged under either the printer identification or the delivery request terminal identification (Keeney, col 7, ln 60-67, and col 8, ln 1-7, wherein fees may be charged for a plurality of options, e.g. job size, time for storage, monthly fee, per use fee, print quality, print size, etc.. Fees are charged either under the printer polling device (which

may be in a variety of locations, as explained above), print job source, or any other device capable of communications via the network).

Regarding claim 13, which depends from claim 2, claim 13 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 13.

Regarding claim 14, which depends from claim 3, claim 14 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 14.

Regarding claim 15, which depends from claim 5, claim 15 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 15.

Regarding claim 16, which depends from claim 8, claim 16 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 16.

Regarding claim 17, which depends from claim 1, the combination of Yamaguchi and Keeney teaches a print system wherein the printer device is a color ink-jet printer, a color laser printer, a monochrome laser printer or a dot impact printer (Keeney, col 15, ln 34-35, print polling device (controlling communications of print system of Keeney) is compatible with all types of printers, including a color ink-jet printer, a color laser printer, a monochrome laser printer, or a dot impact printer. See also Yamaguchi, paragraph 91, wherein the printer is a laser printer).

Regarding claim 18, which depends from claim 2, claim 18 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 18.

Regarding claim 19, which depends from claim 3, claim 19 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 19.

Regarding claim 20, which depends from claim 5, claim 20 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 20.

Regarding claim 21, which depends from claim 8, claim 21 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 21.

Regarding claim 22, which depends from claim 12, claim 22 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 22.

Regarding claim 23, the combination of Yamaguchi and Keeney further teaches a print system comprising a printer device, a host providing contents and a delivery request terminal connected in between the printer device and the host (Yamaguchi, fig 1, digital copier #1, client #9, internet (not numbered) and WWW Server #11, wherein the WWW server provides contents to the client, which in turn provides the content to the digital copier. Additionally, see Keeney, col 7, ln 50-59, wherein the polling device responsible for communications between content provider and the printer, may be

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located externally from printer), the delivery request terminal provided with a delivery request terminal identification (Yamaguchi, fig 5, Document Location #502, Printer address #503, and User name #504 identifying deliver request terminal), including a nonvolatile memory holding a delivery request information table storing access destination addresses (Yamaguchi, paragraph 119-120, URL provides destination address of content), the delivery request terminal identification and specific information about the printer device (Yamaguchi, paragraph 121-124, printer address and user ID identifies terminal and printer information. Print settings, specific to printer, can be seen in table 1, comprising sheet style, margins, sorting, duplex printing, etc.), executing a delivery request of the contents to the host by sending the delivery request information table to the host, and receiving print data of the contents from the host to send the print data to the printer device, the printer device printing the received print data (Yamaguchi, paragraph 16, wherein imaging device sends delivery request to WWW server, and wherein the printer receives the print data to be printed accordingly), the host receiving the delivery request information table from the delivery request terminal, determining whether the requested contents should be delivered according to the delivery request terminal identification included in the received delivery request information table (Keeney, for example, col 10, ln 56-63, a list of recipients is located at the host, allowing the host to determine if the contents should be delivered. For clarification, with polling device embodied as an external device in Keeney (col 7, ln 50-59), the polling device become the delivery terminal, the server remains the content host, and the printer remains as the printer.), producing the print data of the contents on the basis of the

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specific information about the printer device, and delivering the print data to the delivery request terminal (Keeney, col 14, ln 1-10, as part of the polling query, i.e. deliver request information table, the print data is produced in accordance with the printer specifics, and the data is delivered to the printing device to be printed).

Regarding claim 24, which depends from claim 23, claim 24 recites identical features as claim 2 except claim 2 is dependent on claim 1. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 24.

Regarding claim 25, which depends from claim 23, claim 24 recites identical features as claim 3 except claim 3 is dependent on claim 1. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 25.

Regarding claim 26, which depends from claim 24, claim 26 recites identical features as claim 3 except claim 3 is dependent on claim 1. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 26.

Regarding claim 27, which depends from claim 23, claim 27 recites identical features as claim 5 except claim 5 is dependent on claim 1. Thus, arguments similar to that presented above for claim 5 are equally applicable to claim 27.

Regarding claim 28, which depends from claim 24, claim 28 recites identical features as claim 5 except claim 5 is dependent on claim 1. Thus, arguments similar to that presented above for claim 5 are equally applicable to claim 28.

Regarding claim 29, which depends from claim 25, claim 29 recites identical features as claim 5 except claim 5 is dependent on claim 1. Thus, arguments similar to that presented above for claim 5 are equally applicable to claim 29.

Regarding claim 30, which depends from claim 23, claim 30 recites identical features as claim 8 except claim 8 is dependent on claim 1. Thus, arguments similar to that presented above for claim 8 are equally applicable to claim 30.

Regarding claim 31, which depends from claim 24, claim 31 recites identical features as claim 8 except claim 8 is dependent on claim 1. Thus, arguments similar to that presented above for claim 8 are equally applicable to claim 31.

Regarding claim 32, which depends from claim 25, claim 32 recites identical features as claim 8 except claim 8 is dependent on claim 1. Thus, arguments similar to that presented above for claim 8 are equally applicable to claim 32.

Regarding claim 33, which depends from claim 27, claim 33 recites identical features as claim 8 except claim 8 is dependent on claim 1. Thus, arguments similar to that presented above for claim 8 are equally applicable to claim 33.

Regarding claim 34, which depends from claim 23, claim 34 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 34.

Regarding claim 35, which depends from claim 24, claim 35 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 35.

Regarding claim 36, which depends from claim 25, claim 36 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 36.

Regarding claim 37, which depends from claim 27, claim 37 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 37.

Regarding claim 38, which depends from claim 30, claim 38 recites identical features as claim 12 except claim 12 is dependent on claim 1. Thus, arguments similar to that presented above for claim 12 are equally applicable to claim 38.

Regarding claim 39, which depends from claim 23, claim 39 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 39.

Regarding claim 40, which depends from claim 24, claim 40 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 40.

Regarding claim 41, which depends from claim 25, claim 41 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 41.

Regarding claim 42, which depends from claim 27, claim 42 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 42.

Regarding claim 43, which depends from claim 30, claim 43 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 43.

Regarding claim 44, which depends from claim 34, claim 44 recites identical features as claim 17 except claim 17 is dependent on claim 1. Thus, arguments similar to that presented above for claim 17 are equally applicable to claim 44.

Response to Arguments

Applicant's arguments filed February 2, 2006 have been fully considered but they are not persuasive.

Applicant argues, on page 4 of Remarks, that Yamaguchi does not disclose a printer device provided with a printer identification. The Office cites the Yamaguchi reference at paragraphs 121-122, wherein printers comprise a network address. A printer is identified on a network by its address. Applicant argues that the network address is a dynamic address and is dissimilar to the unique printer identification disclosed in the applicant's specification. The specification is not the measure of invention. Therefore, limitations contained therein cannot be read into the claims for the purpose of avoiding the prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

Applicant argues, on page 5, third paragraph, that Keeny does not disclose a host receiving a delivery request information table from a printer device in claim 1. The Office respectfully disagrees. Citing Keeney for an example of the delivery request information in col 10, ln 56-63, jobs at the host comprise destination information such as users designated to receive the content, content subscribers, or other target audiences. The system of Keeny may perform "pull printing". When a user requests a print job, a

PIN is submitted by the user to the host to identify the jobs, i.e. an access destination address (Keeney, col 9, ln 30-38). This PIN is part of the delivery request table sent from the polling device (which has previously been established to either be a stand-alone unit, integrated into the firmware of the printer, or any other configuration, Keeney, col 7, ln 50-59) which inherently includes specific information regarding the printing device including printer identification (Keeney, col 11, ln 4-6, polling device communicates via DHCP, which inherently includes sending printer identification to establish bidirectional communication).

Applicant argues, on page 6 of Remarks, third paragraph, applicant argues similar limitations regarding claim 23 as those presented above for claim 1. Therefore, similar arguments apply to the rejection of claim 23. Similarly, applicant argues on page 6 of Remarks, fourth paragraph, that Keeney does not disclose a host receiving a delivery request information table, similar to the limitation argued previously for claim 1. Therefore, similar arguments apply to the rejection of claim 23.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER